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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/314,960	05/20/1999	JUNICHI IIDA	P17947	5852

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/314,960

Applicant(s)

IIDA, JUNICHI

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-56 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 and 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-31 and 39-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3-7. 6) ☐ Other: _____

DETAILED ACTION

Response to Preliminary Amendment

1. Applicant's preliminary amendment was received on 8/23/02, and has been entered and made of record. Currently, **claims 20-56** are pending.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. **Claims 20-31, and 39-49**, drawn to a communication apparatus having a memory that stores an address book that includes a plurality of destination addresses, classified in class 358, subclass 440.
 - II. **Claims 32-38, and 50-56**, drawn to a communication apparatus that determines whether a storage time of image data exceeds a storage period of time, and capable of changing the storage period from a terminal apparatus, classified in class 709, subclass 221.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a facsimile server capable of transmitting received faxes as email depending on a destination address stored in an address book, while invention II has separate utility such as network computer that stores image data for a set period of time, whereby the storage time is reconfigurable. See MPEP § 806.05(d).

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with William Pieprz on Thursday, February 27, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 20-31, and 39-49. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-38, and 50-56 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

6. The references listed in the Information Disclosure Statements submitted on 8/20/99, 6/14/00, 12/7/00, 3/5/01, and 6/21/01 have been considered by the examiner (see attached PTO-1449's).

Drawings

7. The drawings are objected to because of the problems discussed in the attached PTO-948. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. **Claims 20-31, and 39-49** are rejected under 35 U.S.C. 102(e) as being anticipated by Rachelson (U.S. Patent Number 6,157,706).

Regarding **claim 20**, Rachelson discloses a communication apparatus (administrative site 100) connected to a terminal apparatus (facsimile machines 110 and computer 120) via a

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network (see Figs. 1, 4A-4C), with the communication apparatus comprising a memory (address book) that stores an address book including a plurality of destination addresses (see Figs. 9A, column 8, line 4 through column 9, line 35), the destination addresses being stored as a structured document (Fig. 9A, column 8, lines 15 through 28), a transmitter that transmits image data to a designated destination address which is stored in the address book, the image data being transmitted via at least one of the network or a telephone network (Figs. 1, 4A-4C, and column 6, line 45 through column 9, line 35), a server that transmits the structured address book to the terminal apparatus when a request for the address book is received from the terminal apparatus, the address book being displayable at the terminal apparatus (see Figs. 5 and 6), and a controller that controls the address book to change a content of the address book in accordance with an instruction from the terminal apparatus (column 2, lines 48 through 54, and column 8, lines 29 through 48).

Regarding **claim 21**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the controller deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (column 8, lines 29 through 48).

Regarding **claim 22**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the controller adds a destination address into the address book, in accordance with an instruction from the terminal apparatus (column 8, lines 29 through 48).

Regarding **claim 23**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the controller edits a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (column 8, lines 29 through 48).

Regarding **claim 24**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the address book includes telephone numbers as the destination addresses (see Fig. 9A, column 6, line 45 through column 7, line 6, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

Regarding **claim 25**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the address book includes e-mail addresses as the destination addresses (see Fig. 9A, column 6, line 45 through column 7, line 6, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

Regarding **claim 26**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the address book includes a destination name and a type of communication, of each destination address, the type of communication indicating one of a facsimile communication and an e-mail communication (see Fig. 9A, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

Regarding **claim 27**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the server transmitting the structured address book and menu items to the terminal apparatus (see Figs. 5 and 6), wherein the structured address book and the menu items are displayed as single image at the terminal apparatus, the menu items being utilized to change a content of the address book (column 8, lines 39 through 64).

Regarding **claim 28**, Rachelson discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise an adding key that adds a destination address (see Figs 5 and 6, being the "2.ADD AN ADDRESS" key).

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Regarding **claim 29**, Rachelson discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise a deleting key that deletes a destination address (see Figs. 5 and 6, being the “3.REMOVE ADDRESS” key).

Regarding **claim 30**, Rachelson discloses the apparatus discussed in claim 27 above, and further teaches that the menu items comprise an edit key that instructs editing a destination address (see Figs. 5 and 6, being the “1.ADDRESS BOOK” key).

Regarding **claim 31**, Rachelson discloses the apparatus discussed in claim 20 above, and further teaches that the terminal apparatus comprises a personal computer (computer 120, seen in Figs. 1 and 4A).

Regarding **claim 39**, Rachelson discloses a communication method using a communication apparatus (administrative site 100) connected to a terminal apparatus (facsimile machines 110 and computer 120) via a network (see Figs. 1, 4A-4C), with the communication apparatus comprising storing an address book including a plurality of destination addresses into a memory (see Figs. 9A, column 8, line 4 through column 9, line 35), the destination addresses being stored as a structured document (Fig. 9A, column 8, lines 15 through 28), transmitting image data to a designated destination address stored in the address book, the image data being transmitted via at least one of the network or a telephone network (Figs. 1, 4A-4C, and column 6, line 45 through column 9, line 35), transmitting the structured address book to the terminal apparatus when a request for the address book is received from the terminal apparatus, the address book being displayable at the terminal apparatus (see Figs. 5 and 6), and controlling the address book to change a content of the address book in accordance with an instruction from the terminal apparatus (column 2, lines 48 through 54, and column 8, lines 29 through 48).

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Regarding **claim 40**, Rachelson discloses the method discussed in claim 39 above, and further teaches that the controlling deletes a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (column 8, lines 29 through 48).

Regarding **claim 41**, Rachelson discloses the method discussed in claim 39 above, and further teaches that the controlling adds a destination address into the address book, in accordance with an instruction from the terminal apparatus (column 8, lines 29 through 48).

Regarding **claim 42**, Rachelson discloses the method discussed in claim 39 above, and further teaches that the controlling edits a designated destination address in the address book, in accordance with an instruction from the terminal apparatus (column 8, lines 29 through 48).

Regarding **claim 43**, Rachelson discloses the method discussed in claim 39 above, and further teaches that the address book includes telephone numbers as the destination addresses (see Fig. 9A, column 6, line 45 through column 7, line 6, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

Regarding **claim 44**, Rachelson discloses the method discussed in claim 39 above, and further teaches that the address book includes e-mail addresses as the destination addresses (see Fig. 9A, column 6, line 45 through column 7, line 6, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

Regarding **claim 45**, Rachelson discloses the method discussed in claim 39 above, and further teaches that the address book includes a destination name and a type of communication, of each destination address, the type of communication indicating one of a facsimile communication and an e-mail communication (see Fig. 9A, column 8, lines 15 through 28, and column 10, line 21 through column 11, line 29).

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Regarding *claim 46*, Rachelson discloses the method discussed in claim 39 above, and further teaches of transmitting the structured address book and menu items (see Figs. 5 and 6), wherein the structured address book and the menu items are displayed as single image at the terminal apparatus, the menu items being utilized to change a content of the address book (column 8, lines 39 through 64).

Regarding *claim 47*, Rachelson discloses the method discussed in claim 46 above, and further teaches that the menu items comprise adding a destination address (see Figs 5 and 6, being the “2.ADD AN ADDRESS” key).

Regarding *claim 48*, Rachelson discloses the method discussed in claim 46 above, and further teaches that the menu items comprise deleting a destination address (see Figs. 5 and 6, being the “3.REMOVE ADDRESS” key).

Regarding *claim 49*, Rachelson discloses the method discussed in claim 46 above, and further teaches that the menu items comprise editing a destination address (see Figs. 5 and 6, being the “1.ADDRESS BOOK” key).

Citation of Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Houghton *et al.* (U.S. Patent Number 6,009,153) discloses a system having a server that stores programmable operating parameters, which can then be communicated to a terminal apparatus;

Feder (U.S. Patent Number 5,872,845) discloses a system that transmits facsimile data as e-mail, having an embodiment featuring a server that stores address information in a database;

Bashoura *et al.* (U.S. Patent Number 5,862,202) discloses a system of routing facsimile messages through the Internet, based on data stored in a table.

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Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
March 10, 2003



**MADELEINE NSUYEN
PATENT EXAMINER**

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